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VB

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/001,737 | 12/31/97 | MIZZEN | 870109.408 |

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EXAMINER
NAVARRO, A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1645 | 9 |

DATE MAILED: 09/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/001,737

Applicant(s)

Mizzen et al

Examiner

Mark Navarro

Group Art Unit

1645

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-31 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 3-10, 19-24 and 31, drawn to DNA encoding a *Streptococcus pneumoniae* Hsp60 molecule, classified in class 536, subclass 23.1.
 - II. Claims 2-10, 19-24, and 31, drawn to DNA encoding a *Streptococcus pyogenes* Hsp60 molecule, classified in class 536, subclass 23.1.
 - III. Claims 11-18 and 25-28, drawn to a Hsp60 polypeptide, classified in class 530, subclass 350.
 - IV. Claims 29-30, drawn to a method of eliciting an immune response, classified in class 424, subclass 184.1.

Upon the election of Group I, II, III, or IV, Applicant's are further restricted to one of the following sequences: SEQ ID NO: 1, 2, 3, 4, 5, 6, 7, or 8.

2. The inventions are distinct, each from the other because of the following reasons:

The invention of Group I, drawn to DNA from *Streptococcus pneumoniae* is distinct from the Invention of Group II-IV, since they are products with different structure and biological properties. The polypeptide is made of amino acids whereas the claimed nucleic acid is made of nucleotides. Further methods known in the art used to make the polypeptide require different reagents and parameters from the methods of making DNA encoding the protein and the method

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of making the polypeptide does not require the DNA. For instance, the protein can be made by Merrifield chemical synthesis or affinity chromatography. Furthermore, Group I is independent and distinct from Group II, since the DNA molecule is isolated from a different bacterial microorganism. As set forth in MPEP 803.04 "nucleotide sequences encoding different proteins are structurally distinct compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121."

Invention IV, drawn to a method of eliciting a response and Invention III, drawn to a protein are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein can be used to elicit an immune response in vivo as claimed, or alternatively may be incorporated into an in vitro assay to detect a titer to the protein.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their separate classification and their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Navarro whose telephone number is (703) 306-3225.



Mark Navarro

Primary Examiner

September 14, 2000